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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,649	02/07/2002	Yevgeniy Eugene Shteyn	US028008	2341

7590 07/31/2006

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EXAMINER

SHANG, ANNAN Q

ART UNIT PAPER NUMBER

2623

DATE MAILED: 07/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/071,649

Applicant(s)

SHTEYN, YEVGENIY EUGENE

Examiner

Annan Q. Shang

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/7/02, 1/8/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claims 4 and 12 are objected to because of the following informalities: In claim 4, line 2 and claim 12, line 2, the claimed limitation "prevent the user from bypassing through the alternative advertisement" is nowhere disclosed in the original specification. Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 3, 5-6, 8-9, 11, 13-14 and 16-17 are rejected under 35 U.S.C. 102(e) as being anticipated by **Plotnick et al (2002/0144262)**.

As to claim 1, note the **Plotnick** reference figures 1-4, discloses alternative advertising in prerecorded media (Personal Video Recorder 'PVR') and further discloses a method of advertising via an electronic device (PVR) of a user, the method comprising:

Enabling the device (PVR, a storage medium for storing content including original advertisement) to detect a user's command (channel changing, fast forwarding, rewinding and other VCR-like function via a user input device) for bypassing through an original advertisement in content (page 4, [0088], [0093-0094], [0125], [0160] and [0171]);

Enabling the device to bypass through the original advertisement (page 13, [0176], [0179], [0185-0187] and [0196]); and

Enabling to render to the user an alternative advertisement representative of the original advertisement and of a lower perceived intrusiveness than the original advertisement (figs.16-17, [0213-0219], [0221-0224]), note that the alternative ad maybe displayed in place of the original ad or in conjunction with the original ad, can be reduced in size, superimposed over the original ad, have a degree of opaqueness, transparent, etc.

As to claim 3, Plotnick further discloses where the user's command configures the device to bypass through the original advertisement when playing out the content recorded in the device with the original advertisement; and where the alternative advertisement is rendered in lieu of the original advertisement (page 4, [0088], [0094] and [0145])

As to claim 5, Plotnick further discloses where the alternative advertisement is video and audio of a shorter duration than that of the original advertisement (page 9, [0142], [0145], [0171-0173], [0184-0185], [0187] and [0196])

As to claim 6, Plotnick further discloses where the alternative advertisement is a still picture ([0187] and [0196]).

As to claim 8, Plotnick further discloses where the alternative advertisement is a graphic displayed on transparency to content (page 3, [0060], [0208], [0213-0219] and [0221-0224]).

As to claim 9, the claimed "An electronic enabling advertising, the device comprising..." is composed of the same structural elements that were discussed with respect to the rejection of claim 1.

Claim 11 is met as previously discussed with respect to claim 3.

Claim 13 is met as previously discussed with respect to claim 5.

Claim 14 is met as previously discussed with respect to claim 6.

Claim 16 is met as previously discussed with respect to claim 8.

As to claim 17, the claimed "A software application for enabling advertising on an electronic device of a user, software application comprising instructions for enabling..." is composed of the same structural elements that were discussed with respect to the rejection of claim 1.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Plotnick et al (2002/0144262)** in view of **Goldschmidt Iki et al (6,226,444)**.

As to claims 2 and 10, Plotnick teaches all the claimed limitations as previously discussed with respect to claims 1 and 9 above, and further discloses where the PVR automatically learns a viewer's programs watched and records programs, enables recording of programs based on a viewer preference, enabling inserting of alternative advertisement in recorded content, etc., (page 7, [0124-0126] and [0128-0130]).

Plotnick fails to explicitly teach where the user's command configures the device to record content without the original advertisement.

However, note the **Goldschmidt Iki** reference figures 1, 3, 7 and 8, disclose a method and apparatus for recording program data without commercials (col.2, lines 16-43 and col.8, line 61-col.9, line 1+).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teaching of Goldschmidt Iki into the system of Plotnick to inhibit the recording of unwanted advertising commercials and further enable playback of commercial-free television programs.

6. Claims 4 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Plotnick et al (2002/0144262)** in view of **Eyer et al (6,588,015)**.

As to claims 4 and 12, Plotnick teaches all the claimed limitations as previously discussed with respect to claims 1 and 9 above, but fails to explicitly teach preventing the user from bypassing through the alternative advertisement.

However, note the **Eyer** reference figures 1-4, 10 and 11, discloses broadcast interactive digital radio and further discloses preventing the user from bypassing through advertisement (col.6, lines 50-61 and col.16, line 28-col.17, line 12).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teaching of Eyer into the system of Plotnick in order to prevent users from bypassing through or skipping the alternative ad, thereby forcing users to watch alternative ads and further enable advertisers to generate income from their ads.

7. Claims 7 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Plotnick et al (2002/0144262)** in view of **Darbee et al (6,002,450)**.

As to claim 7 and 15, Plotnick fails to explicitly teach where the alternative advertisement is rendered on a display of a remote control device associated with the electronic device.

However, note the **Darbee** reference figures 1 and 5-8, discloses a two-way remote control with advertising display (col.4, lines 59-67, col.5, lines 30-39 and col.7, lines 3-32).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teaching of Darbee into the system of Plotnick to

display alternative advertisement on a remote controller in order not to interfere with the main content or program on the TV display.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Schlack et al (2002/0129368) disclose profiling and identification of TV viewers.

Maissel et al (2003/0088872) disclose advanced TV system.

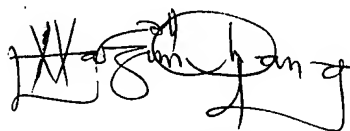
Iggulden (6,404,977) discloses method and apparatus for controlling a videotape recorder in real-time to automatically identify and selectively skip segments of a TV broadcast signal during recording of the TV signal.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Annan Q. Shang** whose telephone number is **571-272-7355**. The examiner can normally be reached on **700am-400pm**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Christopher S. Kelley** can be reached on **571-272-7331**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the **Electronic Business Center (EBC)** at **866-217-9197 (toll-free)**. If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call **800-786-9199 (IN USA OR CANADA)** or **571-272-1000**.

A handwritten signature in black ink, appearing to read 'Annan Q. Shang', with a stylized flourish at the end.

Annan Q. Shang